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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,485	03/06/2004	Mark Rocconi		2484

7590

01/10/2006

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New Fairfield, CT 06812

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/708,485	Applicant(s) ROCCONI, MARK	
	Examiner Sebastiano Passaniti	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/06/2004 - application papers filed.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is responsive to communication received 03/06/2004 – application papers filed.

Claims 1-9 are pending.

Following is an action on the MERITS:

Claim Rejections - 35 USC § 102 and 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1' and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Pan. Note optical aiming device or prism (11) that includes at least one front longitudinal aiming line (12) as well as a rear longitudinal aiming line. Figure 6 for example clearly shows that the prism includes a line (12) to either side of the top or apex portion of the prism, thereby depicting at least one aiming line to the front and to the rear. As to claim 5, the prism is configured as an attachment for the top end of the grip.

Claims 1, 3, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Higley. With reference to Figures 4, 5 and 6 and depending on the orientation of the

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club, the device in Higley shows what appears to be longitudinal aiming lines to the front and to the rear of, for example, a plane arranged perpendicular to the intended target and containing the shaft and passing through the central plane of practice element (10). Specific to claim 3, note lines (26-30), which may be considered to be multiple fine longitudinal lines. As to claim 5, the device (10) is attachable to the top of the grip end of a club via any suitable means such as bolts or glue. As to claim 6, any point such as dot (64) may be considered to be a bump, as best understood.

Claims 1, 2 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Madara. As best as understood, the Madara device includes a handle formed of opaque material with at least one slot running there through, the slot forming the aiming line. As to claim 9, note Figures 6 and 7 showing that a post is mounted to the apparatus, which in turn is configured for mounting within the top end of the shaft.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Pan, Higley or Madara. To have modified the device in any one of the cited prior art references to Pan, Higley or Madara so that the attached practice device detailed in each reference had been constructed as an integral part of the golf grip would have been obvious to one of ordinary skill in the art, since it has been well established that to complete an assembly using a collection of assembled parts or to form the assembly as an integral unit would have involved nothing more than an obvious selection in engineering design and construction. In other words, to have used a single or one-piece construction instead of the structure disclosed by each of Pan, Higley or Madara

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would have merely involved an obvious engineering choice. See In re Larson, 144 USPQ 347 (CCPA 1965); In re Fridolph, 50 CCPA 745, 89 F.2d 509, 135 USPQ 319.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higley in view of Lambert. To have provided an alternative connection means for the Higley device instead of the glue or bolt arrangement disclosed by Higley would have involved an obvious choice in engineering design. Note, Higley even suggests that any suitable joining or connecting means for the element (10) may be used (col. 4, lines 1-9). In this instance, Lambert is cited to show the obviousness of using a slotted lower mounting (14) to facilitate insertion of the practice device (10) within the upper portion of the club grip. The significance of spacing of the centerline of each hole has not been established as it relates to the mounting feature. Thus, the multiple mounting holes are merely viewed as yet another convenient manner of attaching the aiming device, such manner being one of numerous obvious design changes for the skilled artisan.

Claim Rejections – 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, there is insufficient antecedent basis for the limitation "golf shaft" in the claim. Here, the relationship of how the grip and the shaft are connected is unclear.

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Thus, it is not understood how the transparent or translucent material may extend beyond the shaft while still mounted to the grip.

As to claim 2, this claim is incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are as follows: If the aiming lines are formed in either a transparent or translucent material within the context of claim 1 and the claim 1 device is mounted to extend past the end of the shaft, how can the opaque material of claim 2 likewise extend past the end of the golf shaft and further include longitudinal slots that serve as the aiming lines?

As to claim 3, how will rotation of the aiming device create Moire patterns using longitudinal lines?

As to claim 4, is the recitation of a "golf grip" supposed to distinguish from the "grip end" previously recited in claim 1? Note, the butt end of a shaft may form the grip end of the club, either with or without any supplemental gripping material being added thereto.

As to claim 5, it is not clear how the claim is to distinguish the language "an existing golf grip, golf shaft or insert" from the claimed golf shaft already recited in claim 1, or the golf grip already recited in claim 4. Is not the claimed optical aiming device already claimed as part of a combination including a golf club shaft and grip?

As to claim 6, there is no way of being able to interpret what "centered on front of aiming line or between multiple front aiming lines" means absent a more concise

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recitation of the location of the aiming lines with respect to the aiming device and/or grip end.

As to claim 7, where exactly is the bottom of the aiming device? The bottom of the aiming device needs to be more clearly defined.

As to claim 8, the claim is not in a single sentence format. Moreover, the claimed increase in spacing between centerlines of each hole is not understood.

As to claim 9, the relationship between the mounting post and the grip end has been omitted, such omission amounting to a gap between the necessary structural connections. Again, see MPEP § 2172.01

Claim Objections

Claims 1, 3, 4, 5, 6, 7, 8 and 9 are objected to because of the following informalities:

As to claim 1, line 3, "A" should simply read --a--.

As to claim 3, line 2, "A" should read --said-- or --the-- . In line 4, "on which is placed" may simply read --including--.

As to claim 4, "as claimed in claim 1, claim2 or claim 3" may simply read --as claimed in any one of claims 1, 2 or 3--.

As to claim 5, "as claimed in claim 1, claim2 or claim 3" may simply read --as claimed in any one of claims 1, 2 or 3--.

As to claim 6, "as claimed in claim 1, claim 2 , claim3, claim 4 or claim5" may simply read --as claimed in any one of claims 1, 2, 3, 4 or 5--.

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As to claim 7, "as claimed in claim1, claim 2, claim3 or claim5" may simply read -
-as claimed in any one of claims 1, 2, 3 or 5--.

As to claim 8, "as claimed in claim1, claim 2, claim3 or claim5" may simply read -
-as claimed in any one of claims 1, 2, 3 or 5--.

As to claim 9, "as claimed in claim1, claim 2, claim3 or claim5" may simply read -
-as claimed in any one of claims 1, 2, 3 or 5--.

Appropriate correction is required.

Prior art of interest

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See Figures 2 and 7 in Ronnick. Note Figures 12, 14 and 16 in Shiratori. Observe Figure 3 in Garrett. See Figures 11 and 12 in Vela. Note Figure 2 in Sullivan. See Figure 4 in Gadd.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sebastiano Passaniti/sp
January 6, 2006


Sebastiano Passaniti
Primary Examiner